

Arguments/Remarks

Upon entry of the above amendment claims 1-4 and 9-10 will be pending in the instant application. Applicants concurrently submit a Request of Continued Examination (RCE) with the instant amendments for consideration. Applicants do not want the amendments filed January 8, 2009 to be entered into the record.

Applicants amended claim 1. Examples 78-80, located on pages 123-124 of the specification as originally filed support the amendment to claim 1. No new matter has been added.

Applicants note with appreciation that the Examiner withdrew the rejection of claims 1-4 under 35 U.S.C. 112, first paragraph.

Claim Rejections – 35 USC § 102

Blumberg

The Examiner has maintained the rejection of claims 1 and 9 under 35 USC 102(b) as being anticipated by Blumberg *et al.*, (U.S. Patent No. 7,098,212). According to the Examiner, "Blumberg *et al.*, disclose a series of compounds which anticipate the current claims." In particular the Examiner directs the Applicants attention to column 48, compound 1-[4(4-fluorobenzyl)-(2R,5S)-2,5-dimethyl-piperazin-1-yl]-3-(2-hydroxy-4-methylphenyl)propan-1-one, wherein the position corresponding to R₁ in the instant claims is X-R₁₀, wherein X is O and R₁₀ is hydrogen. Applicants respectfully disagree.

In the interest of expediting prosecution of the instant application, Applicants amended the definition of R₁ to: -X-R₁₀, -X-(R₁₀)₂ or -NR₁₁R₁₂; wherein X is a linker having 1, 2, 3 or 4 atoms independently selected from N, C or S. Blumberg *et al.*, fail to disclose a compound wherein X is O. Blumberg *et al.* fail to disclose the present invention as claimed.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Ohtaka

The Examiner has maintained the rejection of claims 1, 4 and 9 under 35 USC 102(b) as being anticipated by Ohtaka *et al.*, (U.S. Patent No. 4,742,062). In particular, the Examiner is of the opinion that the definition of R₁ in the pending claims includes halo and that intermediate compounds in columns 3 and 4 of Ohtaka *et al.*, read on the current claims. Applicants respectfully traverse.

As stated above, Applicants amended R₁ to -X-R₁₀, -X-(R₁₀)₂ or -NR₁₁R₁₂; wherein X is a linker having 1, 2, 3 or 4 atoms independently selected from N, C or S. The instant claims are

not directed to compounds wherein R₁ is halogen. Ohtaka *et al.* fail to disclose the present invention.

Applicants respectfully request withdrawal of the 35 U.S.C. §112 rejection.

Claim Rejections – 35 USC § 112

Claims 1-4 and 9-10 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that the proviso recited in claim 1, "compounds wherein X is -O-C-C-C- are excluded," fails to have support in the original disclosure.

Without acquiescing to the validity of the Examiner's argument and in the interest of expediting prosecution of the instant application, Applicants amended claim 1 by removing the proviso, "compounds wherein X is -O-C-C-C- are excluded."

Applicants respectfully request withdrawal of the 35 U.S.C. §112, first paragraph rejection.

CONCLUSION

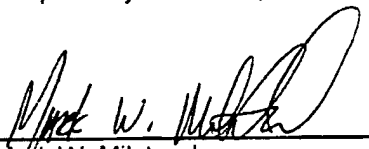
Applicants addressed the issue set forth by the Examiner. Applicants respectfully submit that the present application is in good condition for allowance.

If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

If necessary, the Commissioner is hereby authorized to charge payment to Deposit Account No. 50-4409 for any additional fees under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17.

Respectfully submitted,

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Date: March 6, 2009